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Docket No.: 215544US2

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

RE: Application Serial No.: 09/986,004
Applicants: Takuji MATSUMOTO, et al.
Filing Date: November 7, 2001
For: SEMICONDUCTOR DEVICE AND METHOD OF MANUFACTURING THE SAME
Group Art Unit: 2826
Examiner: A. SEFER

SIR:

Attached hereto for filing are the following papers:

RESTRICTION RESPONSE

No check is attached for fee since it is believed no fees are owed. In the event fees are owed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
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215544US2

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

#5

Election

6/4/02

IN RE APPLICATION OF	:	
Takuji MATSUMOTO, et al.	:	EXAMINER: A. SEFER
SERIAL NO: 09/986,004	:	
FILED: November 07, 2001	:	GROUP ART UNIT: 2826
FOR: SEMICONDUCTOR DEVICE AND METHOD OF MANUFACTURING THE SAME	:	

PROVISIONAL ELECTION

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:

In response to the Restriction Requirement dated April 26, 2002, the Applicants hereby elect Group I comprising Claims 1-18 for examination on the merits in the present application. Applicants make this election based on the understanding that Applicants are not prejudiced against filing one or more divisional applications that cover the non-elected claims.

In addition to making this election, Applicants respectfully traverse this Restriction Requirement for the reason that the inventions of Groups I and II have not been shown to be distinct in the manner required by MPEP §806.05(f).

As the noted portion of the manual indicates, the Patent Office must demonstrate either: (1) that the process as claimed is not an obvious process of making the product and the process as claimed can be used to make other and different products, or (2) that the product

as claimed can be made by another and materially different process.

Page 2 of the Restriction Requirement indicates merely that "step (c) recited in claim 20 could be performed prior to step (B)." First, it is not understood how the interchangeability of the steps of the present inventive method relates to whether the claimed process is not an obvious process of making the product and claimed process can be used to make a different products, as required above in test (1) from MPEP §806.05(f). Further, although two steps relating to the present inventive method are mentioned, the specific steps of a "materially different" process are not set forth, as required above in test (2) from MPEP §806.05(f).

Because the required showing as to a process has not been set forth, Applicants cannot determine what the process being proposed is, much less if it is simply different from the process of Group II or if it is "materially different," as is required. Since the Restriction Requirement fails to set forth a complete process, it is not considered to have met the requirement of MPEP §806.05(f) for showing a "materially different process" for making the product.

Furthermore, MPEP § 803 states the following:

> If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

Although the Office Action has identified separate classifications, and contends that a *prima facie* case of a serious burden has been met, it is respectfully submitted that there is no serious burden in searching and examining the entire application. The Patent Office routinely uses electronic-database searching in the semiconductor arts. In this way, searches can be made for a large number of subclasses, or theoretically all subclasses, without any additional effort. As patents and other publications in this art often contain descriptions of

both a process and the apparatus implementing the process, information as to both process and apparatus can be found in the same publication. It is thus very likely that patents and publications in the field of the claimed process will have descriptions of the apparatus in which the process is implemented, greatly facilitating the prior art search and the consideration of both apparatus and process claims.

In light of the above, a full examination on the merits of Claims 1-20 is hereby requested. In the event that any issues arise in the application which may readily be resolved by telephone, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

Respectfully submitted,

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